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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Customer Number: 20277
 Toshihiro SADAOKA, et al. : Confirmation Number: 4541
 Application No.: 10/089,245 : Tech Center Art Unit: 1616
 Filed: August 21, 2002 : Examiner: Choi, Frank I.
 For: SEBUM ABSORBING PAPER COMBINING HYDROXYAPATITE

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellants' Appeal Brief in support of the Notice of Appeal filed October 15, 2004. Please charge the Appeal Brief fee of \$500.00 to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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 as our correspondence address.**

Docket No.: 50069-111

PATENT



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APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed October 15, 2004, wherein Appellants appeal from the Primary Examiner's rejection of claims 1-3.

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I. REAL PARTY IN INTEREST

This application is assigned to Shiseido Company, Ltd. by assignment recorded on August 21, 2002, at Reel 013219, Frame 0957.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related Appeal or Interference.

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III. STATUS OF CLAIMS

Claims 1-3 are pending and finally rejected in this Application. It is from the final rejection of claims 1-3 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the Final Office Action dated June 15, 2004.

A Request for Reconsideration was submitted on September 15, 2004. According to the Advisory Action dated October 1, 2004, the Request for Reconsideration has been considered; however, the Examiner maintained the rejection of claims 1-3.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is the only independent claim. Independent claim 1 is directed to a sebum absorbing paper used for applying to the skin or for cleaning the skin and is capable of selectively absorbing oxidized sebum. The paper has a basis weight of 5 to 25 g/m² and contains an inorganic filler that includes 50 to 100% by weight of hydroxyapatite.

Sebum is an oil/lipid excreted by glands in the human skin. The sebum forms a film on the surface of the skin that prevents transepidermal water loss (paragraph spanning pages 1 and 2

of the specification). Thus, sebum is important in retaining moisture of the skin. Over time, however, sebum can become oxidized from exposure to air and light, and this oxidized sebum can plug pores in the skin and/or irritate the skin.

Conventional practices of cleaning the skin in this art involve using a thin and soft sebum absorbing paper. The paper although transparent, becomes more transparent after absorbing sebum, which allows the user to visually recognize that sebum has been absorbed (last full paragraph on page 1). A problem with conventional sebum absorbing paper is that the paper not only absorbs old, oxidized sebum, but new sebum as well. Since new sebum is beneficial to the skin, there was a need for a sebum absorbing paper that selectively absorbs oxidized sebum.

The present invention addresses and solves the problem of selectively absorbing oxidized sebum by provision of hydroxyapatite as a substantial portion of inorganic filler within the paper. The hydroxyapatite selectively absorbs lipid peroxide among several types of lipid (paragraph spanning pages 3 and 4), which allows the paper to selectively absorb oxidized sebum from among several types of sebum generated by the skin.

VI. ISSUES TO BE REVIEWED ON APPEAL

1. Claims 1-3 were rejected under subsection (f) of 35 U.S.C. § 102 based upon JP 2002-330820 (hereinafter JP '820);
2. Claim 1 was rejected under subsection (f) of 35 U.S.C. § 102 based upon JP 2003-038248 (hereinafter JP '248); and

3. Claims 1-3 were rejected under 35 U.S.C. § 103 for obviousness based upon EP 0393723 (hereinafter EP '723) in view of JP 11-137336 (hereinafter JP '336) and further in view of JP 63188628 (hereinafter JP '628) or JP 63027411 (hereinafter JP '411).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-3 UNDER 35 U.S.C. § 102(f) BASED UPON JP '820

For the convenience of the Honorable Board in addressing this rejection, claims 2-3 stand or fall together with independent claim 1.

In the Final Office Action dated June 15, 2004, the Examiner cited subsection (f) of 35 U.S.C. § 102, which states that a person shall not be entitled to a patent if "[the inventor] did not himself invent the subject matter sought to be patented." To support this rejection, the Examiner stated only the following in the Final Office Action:

JP 2002330820 expressly discloses a sebum absorbing paper containing 10% hydroxyapatite and 10% talc, each with particle size of 3 microns, having a basis weight of 15 g/m² (See Table 2).

In the Advisory Action dated October 1, 2004, the Examiner further stated:

the IDS and the references JP'820 and JP'248 indicate that Daio Paper Corporation is the assignee which was listed as an assignment in Applicant's own prior document JP 2000-234908.

A rejection under 35 U.S.C. § 102(f) is appropriate where it can be shown that an applicant *derived* an invention from another. It is submitted that, in order to sustain a rejection under this statutory section, it must be demonstrated that applicant acquired the knowledge of the

invention from another,¹ and the question of derivation is one of fact.² Therefore, the Examiner must provide factual evidence that the invention was conceived by another and the conception of the invention was communicated to the inventor. The Examiner, however, has provided no factual evidence that the claimed invention was derived from another. Although the Examiner has asserted that JP '820 and the present invention are commonly assigned,³ it is submitted that this is neither evidence that the claimed invention was conceived by another nor evidence that such a conception of the invention was communicated to Appellants. Therefore, it is submitted that the Examiner has failed to establish that Appellants did not invent the subject matter sought to be invented, as recited in claims 1-3, with the meaning of 35 U.S.C. § 102(f).

THE REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 102(f) BASED UPON JP '248

In the Final Office Action dated June 15, 2004, with regard to the derivation rejection based upon JP '248, the Examiner stated the following:

Claim 1 is also provisionally rejected under 35 USC 102(f) over JP2003038248 as it appears to expressly disclose a sebum absorbing paper containing 15 or 30 or 10% hydroxyapatite having a basis weight of 20, 20, and 5 g/m², respectively. (See Table 1).

In the Advisory Action dated October 1, 2004, the Examiner further stated:

the IDS and the references JP'820 and JP'248 indicate that Daio Paper Corporation is the assignee which was listed as an assignment in Applicant's own prior document JP 2000-234908.

Appellants incorporate herein the arguments previously presented with regard to the rejection of claims 1-3 under 35 U.S.C. § 102(f) for derivation based upon JP '820. The

¹ See New England Brading Co. v. A.W. Chesterton Co., 970 F.2d 878, 883, 23 USPQ 2d 1622, 1626 (Fed. Cir. 1992) (case involving attempted invalidation of issued patent).

² Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).

Examiner has provided no factual evidence that the claimed invention was derived from another. It is submitted that the Examiner's assertion that JP '248 and the present invention are commonly assigned falls short of evidence to support that the claimed invention was conceived by another or evidence that such a conception of the invention was communicated to Appellants. Therefore, the Examiner has failed to establish that Appellants did not invent the subject matter sought to be invented, as recited in claim 1, within the meaning of 35 U.S.C. § 102(f).

THE REJECTION OF CLAIMS 1-3 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON EP '723 IN VIEW OF JP '336, AND FURTHER IN VIEW OF JP '628 OR JP '411

For the convenience of the Honorable Board in addressing this rejection, claims 2-3 stand or fall together with independent claim 1.

The Examiner's Rejection in the Final Office Action

In the Final Office Action, the Examiner relied upon EP '723 to teach a paper containing hydroxyapatite and having a basis weight of 20 g/m². The Examiner also relied upon JP '336 to teach a paper containing talc used to absorb oil from the skin. The Examiner then relied upon either JP '628 or JP '411 "to disclose that hydroxyapatite is used in cosmetic product to absorb oxidized lipids." The Examiner then asserted that one having ordinary skill in the art would have been motivated to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411 to arrive at the claimed invention.

³ Daio Paper Corporation and Shiseido Company, Ltd. are common applicants of JP 2000-23490, from which the present application claims priority.

With regard to the requisite motivation to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411, the Examiner asserted:

However, the prior art amply suggests the same as it is known in the art to use papers containing hydroxyapatite and talc as absorbants, [sic] papers containing talc are known to be used for absorbing oil from the skin and that hydroxyapatite [sic] is used in cosmetic products to absorb oxidized lipids. As such, one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin.

On page four of the Office Action, the Examiner asserted:

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Appellants' Response

The Examiner's primary reference of EP '723 is not directed to a paper used for applying to skin or for cleaning the skin, as recited in claim 1. Instead, as described in fields of application (a)-(g) on pages 9-10 of EP '723, the disclosed function paper with hydroxyapatite is used for (a) deodorants, (b) filter mediums, (c) adsorbents, (d) substitute materials for biomaterials, (e) food wrapping papers, (f) articles in a bioindustry, and (g) articles in a medical treatment. Furthermore, as recited in claim 1, the claimed paper is capable of selectively absorbing oxidized sebum (e.g., lipids excreted from sebaceous glands in the skin); however, this feature is neither taught nor suggested by EP '723.

The Examiner's secondary reference of JP '336 was cited to teach a paper containing talc used to remove oil from the skin. However, JP '336 is completely silent with regard to the use of hydroxyapatite.

The Examiner's tertiary references, JP '628 or JP '411, were relied upon by the Examiner to teach "that hydroxyapatite is used in a cosmetic product to absorb oxidized lipids." JP '411, entitled "Dust Preparation for Skin External Use," discloses a powdery preparation that is applied to the skin to "prevent or improve skin roughness." It is noted that JP '411 discloses a product that is not part of a paper, and JP '411 does not disclose that hydroxyapatite would be effective in adsorbing lipids when used as a filler in a sebum absorbing paper.

JP '628 is also not related to a paper product. Instead, JP '628, entitled "Drug for Skin External Use," is directed to a blend of "a hydroxyapatite power with antiphlogistics and/or keratin release agents." As described in the abstract, the product can be in the form of "a shape of cream, ointment, lotion, tonic, powder." JP '628, however, does not state that the hydroxyapatite can be used as a filler in a paper used to selectively absorb lipids from the skin.

In summary, the applied references describe a non-skin related paper (i.e., EP '723), a paper to be used for cleaning the skin (JP '336), and a pair of non-paper related products (i.e., JP '628 and JP '411).

With regard to the Examiner's *prima facie* obviousness assertion, it is submitted that the mere identification of various claim features in disparate references is insufficient to establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.⁴ The Examiner's assertion "every element of the invention has been collectively

⁴ Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

"taught" in itself is not dispositive, as it has been well recognized that "virtually all [inventions] are combinations of old elements."⁵

The Examiner's stated motivation to combine the cited references is that "one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin." This statement merely describes an expected end result taught by the present disclosure without explaining why this result would have been expected (i.e., the rationale that would have led one skilled in the art to this result).

EP '723 is not directed to a paper used for applying to skin or for cleaning the skin. Despite the discussion of many different uses for the disclosed paper, including use as a filter medium and a food wrapping paper, EP '723 is completely silent about using the disclosed paper for applying to the skin or for cleaning the skin. Although EP '723 discloses that the "functional paper shows preferably a basis weight of 20g/m² or more," which falls within the claimed 5 to 25 g/m², the specific examples disclosed by EP '723 are all 48 g/m² or greater.⁶ This weight of paper in the examples found in EP '723, although presumably appropriate for the heavier duty applications discussed in EP '723, would not have been recognized as appropriate for use on the skin for absorbing sebum, since sebum absorbing papers conventionally are thin and soft.

⁵ In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

⁶ 85 g/m² in Example 4; 99 g/m² in Example 6; 93 g/m² in Example 9, 101 g/m² in Example 10; 103 g/m² in Example 11; 105 g/m² in Example 12, 98 g/m² in Example 13; and 48 g/m² in Example 14.

Based upon the absence of a teaching in EP '723 that the disclosed paper can be used for skin cleansing and the paper basis weights disclosed in the examples of EP '723, which are too heavy to be previously considered as sebum absorbing papers, one skilled in the art would not have recognized EP '723 as being directed to a paper used for applying to the skin or for cleaning the skin, as recited in claim 1. Thus, one skilled in the art of skin cleansing with paper would not look to a reference (i.e., EP '723) that teaches a product that is related neither to skin cleansing nor sebum removal.

References JP '628 and JP '411, cited to teach that hydroxyapatite absorbs oxidized lipids, are completely silent about using hydroxyapatite as a filler in a sebum absorbing paper. Instead, both these references disclose hydroxyapatite in the form of a powder that is directly applied to the skin or is applied via another delivery system, such with a cream, ointment, or lotion. These references, although disclosing many different systems in which the hydroxyapatite can be delivered to the skin, are conspicuously silent with regard to the use of hydroxyapatite as a filler for a sebum absorbing paper. The Examiner, however, has failed to explain why one having ordinary skill in the art would believe, with a reasonable expectation of success, that a product taught as being directly applied to the skin or used in other delivery systems *with the notable exception of paper*, could be applied to the skin with paper.

Notwithstanding that the Examiner has failed to supply a realistic motivation to combine the applied prior art to arrive at the claimed invention, it is submitted that even if the prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Claim 1 recites that the paper is selectively capable of absorbing oxidized sebum. In interpreting this

phrase in light of the plain meaning of the terms used therein and in view of the specification, this limitation is directed to the concept that the paper is capable of selectively absorbing oxidized sebum from other types of sebum. The problem this limitation is intended to solve (i.e., minimizing the absorption of other types of sebum, such as new sebum) has not been recognized by the prior art, and the applied prior art fails to explicitly teach selectively absorbing oxidized sebum.

Furthermore, even if one skilled in the art were to add hydroxyapatite to a sebum absorbing paper with knowledge of the teachings of the applied prior art, the record does not establish that such a paper would selectively absorb oxidized sebum. The applied prior art discloses many different types of fillers for the paper (see, for example, page 9, lines 9-10 of EP '723) that can be combined with hydroxyapatite, and these fillers do not necessarily selectively absorb oxidized sebum. There is no reason to conclude that the Examiner's proposed sebum absorbing paper, although including hydroxyapatite, would selectively absorb oxidized sebum.

The Advisory Action

With regard to the Examiner's citation of case law regarding "what the combined teachings of the references would have suggested to those of ordinary skill in the art," and the statement immediately thereafter that "JP '628 and JP'411 were solely relied upon for ..." (emphasis added), Appellants contend that the Examiner's statement contradicts the cited case law. While the Examiner is content to pick and choose those teachings from the applied prior art relied upon, the test for obviousness is what all the teachings would have suggested to those skilled in the art. Specifically, with regard to JP '628 and JP '411, the Examiner asserted that these references were relied only for their teachings of properties of hydroxyapatite. However, the Examiner has ignored

that these references specifically omit paper as a system for delivering the hydroxyapatite to the skin and would not lead one to be aware of such use. Although using paper to deliver a material to the skin may have been well known at the time of JP '628 and JP '411, and neither JP '628 nor JP '411 mentioned using paper to deliver hydroxyapatite, one skilled in the art would have had no reason to consider the viability of using paper to deliver hydroxyapatite to the skin.

The Examiner also stated that "Applicant [sic] arguments do not provide evidence that one of ordinary skill in the art would not recognize JP '411 and JP '628 would apply to cosmetic-type papers disclosed by the primary reference EP '723." In this regard, the Examiner has misplaced the evidentiary burden. It is the Examiner that has the burden of establishing that one of ordinary skill in the art would recognize that the powders of JP '411 and JP '628 could be applied to the paper of EP '723.

Appellants also note that the Examiner stated that "EP '723 already disclosed the use of hydroxyapatite in a cosmetic paper which is applied to the skin." Appellants respectfully disagree with this assessment by the Examiner of the teachings of EP '723. Upon reviewing of EP '723, Appellants have discovered no citation that supports the notion that EP '723 teaches a paper, comparable to a cosmetic paper, to be applied to the skin. Although EP '723 describes the use of the paper in products that do touch the skin (i.e., diapers, sanitary napkins, gauze mask and innersoles), EP '723 fails to state that the disclosed function paper, and not another material, contacts the skin. For example, with regard to the disclosed gauze mask, EP '723 states that "the filter sheet of the present invention may be inserted between two gauze layers ... or contained in a pocket of the gauze mask." Furthermore, although EP '723 teaches that the function paper can be

used as "a tape for diaplasia, article skin, . . .," one skilled in the art would not recognize a "tape" as being comparable to the claimed "paper used for applying to skin or form cleaning the skin."

Conclusion

Based upon the foregoing, Appellants submit that the Examiner's rejections under 35 U.S.C. §§ 102, 103 are not factually or legally viable. Appellants, therefore, solicit the Honorable Board to reverse each of the Examiner's rejections under 35 §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A sebum absorbing paper used for applying to skin or for cleaning the skin, comprising:

1 to 30 % by weight inorganic filler, said inorganic filler comprises 50 to 100 % by weight hydroxyapatite, wherein

the paper has a basis weight of 5 to 25 g/m² and selectively capable of absorbing oxidized sebum.

2. A sebum absorbing paper according to Claim 1, wherein an average particle size of said inorganic filler is 0.5 to 8 μ m.

3. A sebum absorbing paper according to Claim 1 or 2, wherein said inorganic filler comprises 0.5 to 50 % by weight talc having the average particle size of 0.5 to 8 μ m.